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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,563	05/10/2001	Hirokazu Uchio	B422-150	6252

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,563

Applicant(s)

UCHIO ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23-October-2006 has been entered.
2. The amendment filed on 23-October-2006 has been received and entered. Claims 1-26, and 33-35 have been cancelled. Claims 27-32 are now pending.

Claim Objections

3. Claim 32 is objected to because of the following informalities:

Claim 32, line 8, recite "to realize a displaying and controlling" is not proper grammatical English, the verb tense need to be matched as such the recitation should state "to realize the step of displaying...etc." or to state "to realize a display...etc.". Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2165

5. Claims 27, 31, and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are software per se only since they raise the question to whether the analyzing, selecting and discovering would all reasonably be interpreted by one of ordinary skill in the art in view of Applicant's disclosure as potentially being software routines. If so, the claims includes an embodiment directed to software, per se, since the claimed system lacks inclusion of the hardware necessary for any of the underlying functionality to be realized. For those claims to be statutory, at least one of the elements must include hardware in accordance with the disclosure.

For claim 28, there does not appear to be enough support in the specification for the "means" to be anything more than software modules.

For claim 31, there appears to be no hardware tied to the method steps in order to realize their functionality. They instead appear to be series of functional steps missing hardware components. The claim should be amended to recite computer hardware in the body of the claim.

For claim 32, computer programs must be stored and executed by a computer. In this case, the program does not appear to be "stored in a computer readable storage medium" in order to be executed by the computer.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 27, 31, and 32, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27, 31, and 32 recites the limitation "the actual document number" and "the actual reference number" in lines 6, and 8. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, what is an "actual number" is vague and unclear specifically with respect to Applicant's own disclosure. There appears to be inconsistency between the claims and the specification in the definition given to "actual reference number". The specification on page 46, lines 5-6 is considering the "reference number" to be the "case number associated with a company" while page 46, lines 9-10, discusses a "family number" and page 47, line 23, talks about a "document number". Which of those definitions is being claimed? And out of those definition which constitute an "actual" number vs. a non-actual number? The claimed recitation is not clearly defined as such hard to interpret as such, the Examiner is interpreting the "reference number" to be "document ID" and/or "grouped patents under the same company name".

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindh (U.S.

Pub. No. 2002/0022974 A1)- Cited in the previous office action.

As to claims 27, 31, and 32, Lindh discloses an information processing method, apparatus, and program storage medium storing a program for realizing an information processing method, comprising the steps of:

accumulation means for accumulating information about a related prior art document which is cited in a prosecution of a patent application in a first country and a related prior art document cited in another prosecution of a counterpart patent application in a second country different from the first country (See page 4, paragraphs 0039-0040, wherein all citation information is stored in the database is taught); and

display control means for displaying a list of the actual document numbers of the related prior art documents of a said patent application together with the actual reference number of the patent application to be prosecuted (See pages 1-2, paragraph 0018, and see page 2, paragraphs 0023-0024).

As to claim 28, Lindh discloses wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior art document (See page 3, paragraph 0032).

As to claim 29, Lindh discloses wherein said display control means displays descriptions indicating correspondence between the prior art document and a rejection reason (See page 2, paragraph 0026, also page 3, paragraph 0036).

As to claim 30, Lindh discloses wherein said display control means displays a list of applications by which the prior art document has been cited relating to the prior art document (See page 2, paragraph 0018, column 1, teaches variety of display choices including related patents, prior art, country, etc.).

Alternatively, the claims are rejected under:

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al. (U.S. Patent No. 5,991,751).

As to claims 27, 31, and 32, Rivette et al. discloses an information processing method, apparatus, and program storage medium storing a program for realizing an information processing method, comprising the steps of:

accumulation means for accumulating information about a related prior art document which is cited in a prosecution of a patent application in a first country and a related prior art document cited in another prosecution of a counterpart patent application in a second country different from the first country (See Figure 61, and see Figure 125); and

display control means for displaying a list of the actual document numbers of the related prior art documents of a said patent application together with the actual reference number of the patent application to be prosecuted (See Figure 13, and see Figure 125, and see Figure 154A, wherein “Patent Number” and /or application Number is displayed as well as related prior art cited both US and Foreign, and wherein “actual reference number” reads on “Document #”).

As to claim 28, Rivette et al. discloses wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior art document (See column 49, lines 46-67, and see column 50, lines 1-64).

As to claim 29, Rivette et al. discloses wherein said display control means displays descriptions indicating correspondence between the prior art document and a rejection reason (See column 90, lines 51-64, also see column 117, lines 25-40, wherein “patent case” includes prosecution history).

As to claim 30, Rivette et al. discloses wherein said display control means displays a list of applications by which the prior art document has been cited relating to the prior art document (See Figure 61, also see column 118, lines 34-41).

Response to Arguments

12. Applicant's arguments filed 23-October-2006 have been fully considered but they are not persuasive.

The Examiner maintains the office action rejection under Lindh in light of the 112, second paragraph rejection presented above as such, Lindh on page 1-2, paragraphs 0018, and 0023-0024, teaches displaying a group of patents and patent numbers grouped by company name i.e. family reference and actual patent number.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Neeven Abel-Jalil', with a stylized flourish at the end.

Neveen Abel-Jalil
November 12, 3006